

No. 3052.

United States
Circuit Court of Appeals, 7
FOR THE NINTH CIRCUIT.

Fred Stebler,

Appellant,

vs.

Porterville Citrus Association,

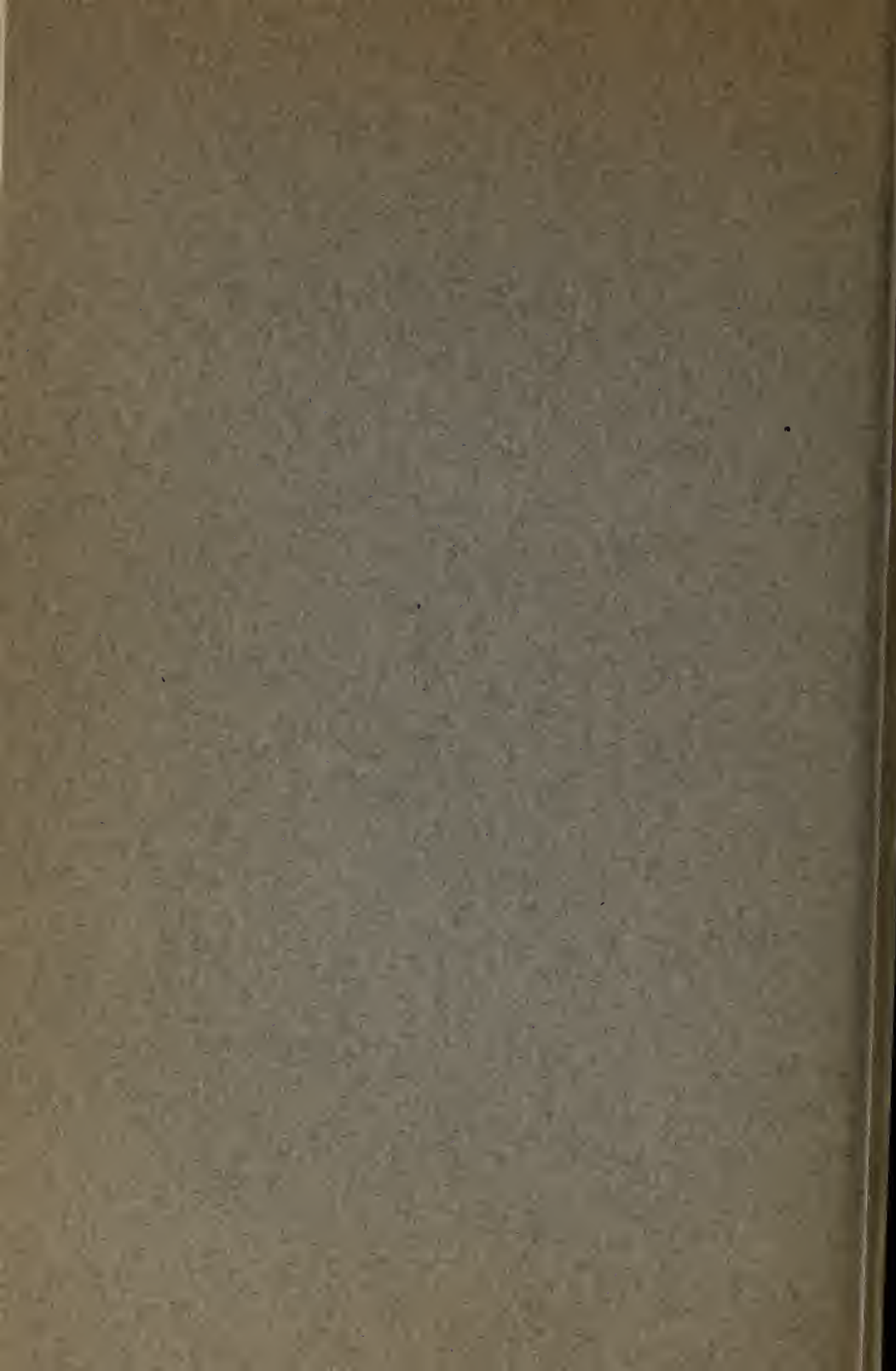
Appellee.

APPELLANT'S BRIEF.

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APPELLANT'S BRIEF.

This case comes before this court upon an appeal by Fred Stebler, complainant in the court below, from a final decree in a suit in equity dismissing his bill of complaint against the defendant and appellee, Porterville Citrus Association. The suit is one for infringement of letters patent No. 775,015 granted November 15th, 1904, to Thomas Strain.

For convenience the parties will be herein referred to as complainant and defendant.

The title of complainant to the patent in suit was stipulated. The machines involved and charged to infringe the Thomas Strain patent are the same machines which are involved in the suit in this court entitled Porterville Citrus Association, Appellant, v. Fred Stebler, Appellee, No. 2960, and this appeal is heard upon the short transcript of record printed herein (containing simply the pleadings, the decree, the minute order of the District Court that this suit "be and hereby is combined for final hearing with cause A 44, Equity, between the same parties" the assignments of error and appeal papers) and the transcript of record of the trial of the combined causes certified to this court and filed as the transcript of record on said appeal No. 2960. References in this brief to the transcript of record will therefore refer to the record in appeal No. 2960.

The Thomas Strain patent discloses three inventions, all applicable to fruit graders. It is with *two* only of these that appellant's appeal deals.

The Thomas Strain patent discloses, describes and claims a preferred embodiment of each of these three inventions.

The first of these three inventions is a means of grading fruit wherein the roller side of the gradeway is adjusted. With this invention appellant's appeal does not deal.

The second invention described in the Strain patent is directed to means for delivering the graded fruit to suitable bins and distributing throughout the length of the *fixed* bin spaces the graded fruit so as to utilize

the whole of such bin space. This feature is charged to be infringed.

The third invention disclosed in the Strain patent is the grading element composed of the alternate Strain invention, which consists in providing a grader element composed of a rotating wall and a suitably supported belt by which the fruit runway is formed and adjusting means by which the belt may be adjusted at predetermined points toward or away from the belt to provide the grade openings or discharge openings for the various sizes or grades of fruit. This Strain invention is charged to be infringed by the defendant's machines.

So far as the second of these inventions is concerned, to-wit, that which may be termed the fruit distribution feature,—this patent has been fully considered in the briefs filed on appeal No. 2960. The object of this Strain invention is set forth in the Strain patent as follows:

“To provide means whereby the fruit will be thoroughly mixed or delivered into each bin in such a way that the several sizes of fruit in each bin are perfectly distributed. This is a valuable feature, for the reason that although the average size of fruit in different bins will vary, still the actual size of fruit delivered into each bin will also vary somewhat.” [Transcript Record, page 528, lines 13 to 21.]

The means thus referred to by Mr. Strain comprise the lower portion of the inclined belt 10 and the brackets 36a and deflector 36b in conjunction with the fixed and non-adjustable bins.

It is to be noted that in the drawings of the Strain patent there is shown a double or two-runway grader. That is to say, each side of the machine is complete in itself for the operation of grading and distributing to bins the fruit. In this respect defendant's machines are the same, as they are each provided with two grade-ways, distributing belts for each grade-way, and a series of bins for each grade-way. In the Strain patent his preferred embodiment of this feature of the invention is described in connection with the lower or inclined part of the belt 10 as follows:

"36a represents brackets attached to the edges of the leaves. Mounted on each bracket is an inclined deflector 36b. The deflector 36b is provided with a lug 36c, and the latter is adjustably mounted on the bracket 36a and clamped thereto by means of a set screw 36d. The deflector 36b may be placed at any desired point along the bracket 36a, so that fruit will be shunted into the bin at any desired point. This allows the fruit to be delivered into the bin in such a way that it is thoroughly mixed. If the fruit were delivered into the bin direct from under the grading-rods, the size of fruit in the bin at one extreme side would be larger than the size at the other side. To obviate this difficulty, I employ the guards 36 and deflector 36b, by means of which the fruit is thoroughly mixed in the bin, and no particular size occupies a particular place in the bin, as would be the case were the guards and deflectors not employed." [Transcript Record, page 529, lines 65 to 85; page 2 of the specification of the Strain patent.]

Of this Thomas Strain invention the explanation thereof by defendant in its brief, on appeal No. 2960, is directly in point. We quote from appellant's brief on appeal No. 2960 the following explanation of this second Thomas Strain invention:

"We find the apparatus therein disclosed to be for a fruit grader, and the embodiment of the invention, as therein disclosed, is a fruit grader having a fruit runway, formed of two parallel members, one member thereof constituting the rotary grading element of the apparatus, and which grading element is designated by the reference numeral 20 in the drawings of the letters patent, and is more clearly shown by reference to Figs. 3, 4, 5, 7 and 9 of said drawings. Beneath this member and extended to one side thereof is arranged a longitudinally traveling conveyor belt or carrier 10, onto which the sized fruit escaping from the discharge outlets of the grader moves by gravity, the said carrier moving longitudinally over the downwardly inclined sections of the supporting bed of the apparatus. Alongside of the downwardly inclined bed portion of the apparatus is situated a series of longitudinally disposed fruit receiving bins into which the sized fruit is received, these bins being co-extensive with the length of the grading apparatus. The sized fruit, unless otherwise obstructed, flows by gravity from the outlet aperture for the sized fruit, transversely of the longitudinally traveling belt or conveyor into the bins located for the reception thereof. However, there is associated with the longitudinally traveling carrier of the said apparatus a plurality of barriers or arresting members 36, which are arranged parallel with the endless

traveling belt or carrier 10, and associated with each of said barrier members 36 is a longitudinally adjustable barrier member 36-B. These two members co-acting form a chute or runway, the member 36 serving to arrest the downward gravity flow travel of the sized fruit transverse of the carrier and change its direction of travel to a direction parallel with the endless moving carrier belt 10, the associated longitudinally disposed adjustable barrier member 36-B serving the purpose of deflecting the fruit from the traveling belt or carrier into the bins at any desired point throughout the length thereof. Inasmuch as these co-acting members 36 and 36-B are arranged longitudinally of the grading apparatus and parallel with the endless traveling belt or carrier 10, they form throughout the length of the apparatus a series of chutes for guiding the sized fruit and directing the same to any desired discharge point relative to the fruit receiving bins. With the Thomas Strain apparatus, it is the members 36 with its associated longitudinally adjustable members 36-A which form the chutes for directing the sized fruit relative to any particular or desired portion of the fruit receiving bins." (Brief of appellant Porterville Citrus Association, case 2960, pages 28 and 29.)

In the foregoing there are two errors. The belt 10 of the Thomas Strain patent is not a separate belt or a conveyor belt *per se*, but the lower side of the grading belt 10 is used as a conveyor and the barrier members 36 and 36b arranged along the lower side of such grading belt. The second error is defendant's statement that the barrier member 36b serves the purpose

of deflecting the fruit from this belt into bins "at any desired point throughout the length thereof." This language is in error if read in the sense that the bin space is adjustable or that the Thomas Strain conception in any manner contemplated adjustability of the bins or the carrying of a given grade or size of fruit from one grading outlet or opening over and beyond the bin arranged opposite such outlet and to a succeeding bin or bins. This result cannot be secured with the Strain invention.

On page 31 of the same brief the Porterville Citrus Association says:

"In the Thomas Strain patent the means which control the discharge of the fruit relative to any given position of the fruit receiving bins, is the longitudinally adjustable member 36-B, which co-operates with its associated member 36, to form a guide chute. The member 36 is a fixed barrier arranged to arrest the downward gravity flow of the fruit from the sizing outlets of the grader or sizer toward the fruit receiving bins, while the associated member 36-B serves to act as a longitudinally adjustable barrier for controlling the discharge point of the sized fruit from the longitudinally movable carrier relative to the fruit receiving bins. The purpose of such longitudinally adjustable barriers being to evenly distribute the fruit within the bins."

The Porterville Association's brief, then quoting lines 13-31 of page 1 of the specification of the Thomas Strain patent and lines 65-85 of page 2 of the Strain patent specification, and said brief (page 32) continues as follows:

“By means of these longitudinally adjustable deflectors or barriers, the point of discharge for the sized fruit relative to the bins is under the absolute control of the operator, so that the fruit is not only evenly distributed within the bins, but, equally so, the fruit is prevented from pyramiding at any portion of the bin.”

After thus discussing the construction and inter-relation of the parts of the drawings and description of the Thomas Strain patent said brief on behalf of the Porterville Association quotes certain testimony of witnesses in its behalf respecting this Thomas Strain machine, and then proceeds:

“We particularly direct attention to this testimony, for the reason that the function given for the member 36-B of the Thomas Strain patent is *the function and only function of the longitudinally adjustable barriers of the appellants’ machine.*” (Appellant’s Brief in 2960, page 38.)

On page 80 of the Porterville Association’s said brief on said appeal No. 2960 it is stated:

“In the appellants’ machine a return is made to the utilization of a longitudinally movable barrier for controlling the discharge of the fruit from the longitudinal conveyor relative to any given point within the fruit bin situated for the reception of such sized fruit, *the same being a return to the Thomas Strain patent* and utilization of a simpler type of longitudinally adjustable barrier to that shown by the element 36-B of the said Strain patent. The difference between appellants’ longitudinally movable barrier and the longitudinally movable barrier 36-B of the Thomas Strain patent,

residing in provision being made whereby under normal working of the apparatus the said barrier is not employed; whereas, in the device of the Thomas Strain patent the longitudinally adjustable barrier 36-B is attached to and forms a permanent portion of the apparatus. In fact, *the longitudinally adjustable barrier of appellants' machine performs a function corresponding to that of the longitudinally adjustable member 36-B of the Thomas Strain patent.* This we not only ascertain from a reading of the Thomas Strain patent, and the knowledge of the operation of the barrier member of appellants' machine, but are so told by the testimony of Thomas Strain, Sr. [Record, p. 424]; by the testimony of witness Ofstadt [Record p. 385-386]; by the testimony of witness Thomas Strain, Sr. [Record p. 320]; by the testimony of witness Milligen [Record p. 305]; by the testimony of witness Brookhart [Record, page 336]: and further by the testimony of appellee's expert witness, Knight, which testimony is as follows:

“‘Q. (By Mr. Acker): And the part 36 then serves as a longitudinally disposed barrier for arresting the transverse movement of the fruit as it flows from the grading rod toward the fruit receiving bin, is that correct?

‘A. Yes.

‘Q. And to that extent it serves the same purpose, does it not, as the barrier employed in the defendants' device for arresting the line of travel of the fruit flowing by gravity from the sizing member towards the fruit receiving bin?

‘A. Yes.

‘Q. Now, what purpose does the part marked 36-B in the device of the Thomas Strain patent of Defendants' Exhibit Number 3 serve?

'A. It determines the particular point at which the fruit will be deflected from the depression in the conveyor and discharge into the bin.

'Q. That member 36-B is longitudinally adjustable relative to the longitudinal traveling carrier member, is it not, Mr. Knight?

'A. Yes.

'Q. And what is the purpose or what function is performed by the member 36-B of the said Thomas Strain patent?

'A. The purpose or function of this is to discharge the fruit into the bin at a given point so as to distribute the fruit uniformly throughout the bin, the idea being that if the fruit is allowed to run into the bin from the grader at different points along the bin there will be an equal distribution.' "

In summing up appellant's argument on said appeal No. 2960 appellant Porterville Citrus Association therein, says in its brief on page 87:

"Appellant's device in general construction and mode of operation conforms to the invention of the prior Thomas Strain patent 775,015."

We might rest the submission of this branch of this appeal upon the solemn assertions of the Porterville Citrus Association thus made to this court. If such assertions are true they conclusively show the appropriation by the Porterville Citrus Association and Mr. Parker of the Thomas Strain invention under discussion. In fact, it would seem that infringement is admitted.

There is no defense to the validity of the Thomas Strain invention under discussion. It is conceded that he was the original and first inventor thereof.

Claims 18 and 19 of the Thomas Strain patent refer particularly to this portion of the Thomas Strain invention, while claim 37 thereof refers to a general combination of the third or alternative grading element construction in combination with this arrangement of the means for distributing fruit throughout a given bin. This latter claim 37 will be discussed after a discussion of the third or alternative form of the Thomas Strain invention.

Claims 18 and 19 are as follows:

“18. A fruit-grader comprising means for conveying fruit along a definite line of travel, said means being inclined transversely of the line of travel, an inclined grading-rod lying along said line of travel above said conveying means, means for rotating said grading-rod, and stationary guards and deflectors mounted above said conveying means.

“19. A fruit-grader comprising means for conveying fruit along a definite line of travel, said means being inclined transversely of the line of travel, an inclined grading-rod lying along said line of travel above said conveying means, means for rotating said grading-rod, and stationary guards mounted above said conveying means, each guard comprising offset walls, each wall lying in different vertical planes, the inner wall lying adjacent said grading-rod.”

To avoid controversy let us adopt, for the sake of comparison of these claims, the description of defendant's machine as given by appellant Porterville Citrus Association in its brief in case No. 2960 and refer to the drawings inserted opposite said page.

Claim 18 of the Thomas Strain patent calls for the following elements, which, as they are recited, will be pointed out in the defendant's machine:

“means for conveying fruit along a definite line of travel, said means being inclined transversely of the line of travel.”

In defendant's machine the grading belt and the conveyor belts C, C', all extend along the line of travel and are inclined transversely of the line of travel. The grading belt carries the fruit along under the roller section until it is discharged through the proper grade opening. As we have heretofore pointed out in this comparison with the Thomas Strain invention, the defendant has not utilized a portion of its grading belt as the conveying belt of its distributing system, but it provides separate narrower belts therefor which form in effect a continuation of the grading belt. The function, however, is the same. This is admitted by the defendant in the portions of its brief heretofore referred to.

“an inclined grading-rod lying along said line of travel above said conveying means.”

In the Strain patent this is the inclined grading rod 20. In the defendant's machine it is the inclined grading rod made up of a series of rollers which extend above the belt for the same purposes as in the Thomas Strain patent.

“means for rotating said grading-rod.”

Unquestionably there are means for rotating both the grading rod 20 and the grading rod made up

of a series of rotating rollers in defendant's machine. It will be noted in this connection that all of the rollers on the roller side of the fruit runway in defendant's machine turn in unison and form a continuous roller side. This is one of the very factors which was so much urged on this court in the appeal of Mr. Parker in case 2772 in this court, the opinion being reported in 240 Fed. 703.

"stationary guards and deflectors mounted above said conveying means."

In the Thomas Strain patent drawings the stationary guards are shown at 36 and the deflectors as the parts 36b. In the defendant's machines the stationary guard is formed by that portion of the frame from which the outlets E are cut. (Defendant's drawings opposite page 76 of its brief in case 2960.) This guard is stationary and performs identically the same function as the stationary guard 36. [See for example Record, page 526, Figs. V and VI of the drawings of the Thomas Strain patent.] It will be noted in this connection that this stationary guard is in one vertical plane while the deflector 36b is arranged in another or lower plane and corresponds to the barriers F in defendant's machine, only two of which are shown in the drawings, Fig. 2 of defendant's brief, and none of which are illustrated in Fig. 1. Defendant not only admits, but has urged, that the function of these parts is the same as the function of the corresponding parts in the Thomas Strain device.

The 19th claim of the Thomas Strain patent differs from the 18th only in that the guards preventing the

fruit from yielding to gravity and running off the inclined belt are described as arranged in sections, one section being above the other and the sections being offset. This is also true in defendant's machine as illustrated in Fig. 2 of defendant's drawings of its machine, defendant's brief, page 76, where it will be seen that the upper guard is formed by a portion of the framework of the machine and that below the grade-opening or discharge outlet E is arranged a barrier piece or guard corresponding to the lower guard of the Thomas Strain patent. It will be noted also that defendant's machine corresponds with the language of the latter part or last clause of this 19th claim in that the inner wall or guard lies adjacent the grading rod. This is identically the location of the guard formed by the piece from which the outlets E are cut. This piece blocks up any possibility of the fruit running out at this portion and this is the identical function of the upper portion of the guard 36 of the Strain patent.

The rule of patent law that making in two pieces or parts an element of a combination without substantially changing the function or mode of operation does not avoid infringement is too well settled to need the citation of authority. See, for example:

Standard Co. v. Fastener Co., 113 Fed. 162.

This rule has been often applied by this court, as in Kings County Raisin & Fruit Co. v. U. S. Consolidated Co., 182 Fed. 59.

Giving, then, this Thomas Strain patent and claims 18 and 19 thereof only a fair scope and not requiring

the broadest or most liberal application of the doctrine of equivalency, it is clear that defendant's machines infringed both of these claims and that defendant has, as it has conceded, appropriated this essence of the Thomas Strain invention.

Complainant's expert, Mr. Knight, in considering this feature of the Thomas Strain invention testifies:

"A. Comparing the guides or deflectors in the Porterville machine, as shown at H in Exhibit 5 with the so-called guards indicated at 36 in figure 1 and 11 of Exhibit 3, the function of these guards is to deflect the fruit and cause it to leave the conveyor at a definite point so that it will be discharged into the bin at the proper point, and in this respect this function of the guards in the Plaintiff's Exhibit 3 is performed by the guards H, Exhibit 5, it being understood that these guards 36—

Q. (By the Court): Where? Point it out.

A. Right here. (Indicating to the court.)

Q. Oh, yes.

A. —do not have the longitudinal adjustability which is common to the Porterville machine, Exhibit 5, to Exhibit 3, but insofar as they form a definite control of the path of the fruit from each grader opening to a definite part of the corresponding bin, they perform the function of Exhibit 3.

Q. (By Mr. Lyon): Do they perform that function in a different or substantially the same manner as the deflectors or guards of Exhibit 3?

A. In my opinion, they perform the function in substantially the same manner for the reason while these two parallel opposite portions of the guard

36, in Exhibit 3, are connected by an oblique portion, yet the same effect is produced by the two parallel opposite guard members shown at H at the right-hand side of Exhibit 5, these guard members overlapping, so that when the fruit runs past the end of the upper guard member, gravity will carry it down against the lower guard member, and it will then run along the same for discharge into the bin at a definite point."

Thomas Strain's Alternative Grader or Sizer Invention.

Reference has heretofore been made to the fact that the Thomas Strain patent showed three inventions. We have now to deal with the third of these. It refers to the construction and formation of the grading element and to the means whereby the grading openings or outlets may be adjusted. Instead of adjusting the roller side of the fruit runway Thomas Strain conceived the idea of adjusting the belt toward and away from the roller. His means for so doing are illustrated in Figs. VII and IX of his drawings and are described as follows in his specification:

"The space between the rods 20 and the conveyor-belt may be adjusted in two ways—either by raising or lowering the grading-rods 20 by means of the arms 21, or by raising or lowering the leaves 13 by moving the wedges 16 in or out by manipulation of the levers 17. *The latter method is preferable* for the reason that it does not throw the grading-rod 20 out of its natural alinement. It should be understood that as the grading-rod 20 is slender it permits of being adjusted within reasonable limits—that is, it per-

mits being thrown out of straight alinement. By raising and lowering the leaves 13 accurate adjustment of space may be secured for each section of the grader. It should be understood that the movement of the leaves or of the rods 20 when being adjusted is very slight, comparatively, and that the guards 36 are arranged a sufficient distance above the conveyor-belt to allow the desired movement in adjusting the leaves." [Transcript Record, page 530, lines 110, *et seq.*]

It is thus seen that instead of adjusting portions of the roller side of the run-way towards the belt, as involved in the *Stebler v. Riverside Heights Ass'n* litigation, 205 Fed. 735 and 240 Fed. 703, Thomas Strain has provided a different mode of operation, consisting of adjusting progressive portions of the belts nearer the rollers. This can be accomplished in a device wherein a flat wide grading belt is used, but it cannot be accomplished in a device wherein a round belt or rope like that of the Robert Strain re-issue patent [Transcript Record, page 511] is used.

Defendant, in its machines, uses this alternative construction of grader element. It is true that it does not use the exact form of "hinged leaves" 13. Instead of providing the hinged form of support for the traveling grader belt it provides in its machines the plates or leaves X having adjusting screws Y, as set forth in Mr. Knight's sketch, Complainant's Exhibit No. 10 [Transcript Record, page 559]. There is one of these plates X mounted in an opening in the bed plate or supporting table (over which the grading belt runs) directly opposite the reduced portion or smaller gradua-

tion of each of the roller sections, and by turning the threaded bolt Y the plate X may be raised or lowered to raise or lower the belt toward or away from the surface of the roller, thereby adjusting the grade-opening. It is by this means that the grade-openings or discharge outlets of the defendant's machine are adjusted. The sole difference between the specific form shown and described by Thomas Strain and the defendant's form is in the mounting of these leaves or plates X. That the result is accomplished in identically the same way, i. e., by raising or lowering the leaf or plate and thereby raising or lowering the belt toward or away from the surface of the rotating members is apparent. There is here then merely a change of form without change of function or interrelation of parts.

In *Louden Machinery Co. v. Strickler*, 195 Fed. 751, 756, the Circuit Court of Appeals for the Seventh Circuit says:

"Whether the 'annular lip' be supported in its functioning position by a dog having a solid body or a skeleton frame is immaterial to the actual invention disclosed and claimed. *Form is material only so far as it is essential to the operation, or indispensable, by reason of the state of the art, to the novelty of the claim.*"

In *Ide v. Trorlicht, Duncker & Renard Carpet Co. et al.*, 115 F. 137, the Court of Appeals (8th Cir.), says:

"Mere changes in the form of a device, or of some of the mechanical elements of a combination, will not avoid infringement, where the principle

or mode of operation of the invention is adopted, except in those rare cases in which the form of the improvement or of the element changed is the distinguishing characteristic of the invention.”

The Circuit Court of Appeals for the Sixth Circuit, in *Dowagiac Co. v. Superior Drill Co.*, 115 Fed. 886, says:

“One does not escape liability for infringement by changing the form or dimensions of the parts of a patented combination, where such change does not break up or essentially vary the principle or mode of operation pervading the original invention.”

The Circuit Court of Appeals of the Seventh Circuit, in *Adam v. Folger*, 120 Fed. 260, says:

“Variation of form, location or sequence of the elements of a combination from that defined in the claim of a patent where such location is not essential to the result of the patentee desired, nor made indispensable to novelty by the state of the art, does not avoid infringement as would omission of an element from a combination.”

And in *Benbow-Brammer Mfg. Co. v. Simpson Mfg. Co.*, 132 Fed. 614, the court says:

“A specific description of an element in a claim does not operate as a limitation to the form shown unless it is of the essence of the invention, and evasion of the specified form will not escape infringement when the substance of the invention is copied, as a court does not judge about similarities or differences by the names of things, but looks to the machines, or the several devices or elements, in the light of the function they perform.”

We thus find that we have for consideration a thing or entity,—a combination,—which is for a given purpose and consists of certain parts or elements having specified relations to each other to perform certain functions. This organization must be considered “in the law of what they (the elements or parts) do or what office or function they perform.” (Bates v. Coe, 98 U. S. 31.)

As said in *Columbia Wire Co. v. Kokomo Steel & Wire Co.*, 143 Fed. 116:

“Infringement of a combination claim is not escaped by transposition and rearrangement of some of the elements where there is no substantial difference in principle or result of the combined means and operation. *A patentee is entitled to protection against evasions of the wording of a claim.*”

As said in *Wagner Typewriter Co. v. Wyckoff, Seamans & Benedict*, 151 Fed. 585-593:

“Infringement is not avoided by changes in a patented machine which are non-essential, as by changing the position of parts or transferring a function from one part to another, without affecting the principle or mode of operation.”

In *Ferry-Hallock Co. v. Hallock*, 142 Fed. 172, 176, the court says:

“Where the whole substance of an invention—that which entitled the inventor to a patent—may be copied in a different form, it is the duty of the court to look through the form of an alleged infringing device for the substance which the patent

was designed to secure, and where that is found there is infringement.”

In *Seeger Refrigerator Co. v. American Car & Foundry Co.*, 171 Fed. 416, it is said:

“Infringement is shown where the alleged infringing device operates on the same principle as that of the patent, and accomplishes the same result in substantially the same way by equivalent means; the only difference being in the form or proportions of the parts.”

In *Weber Electric Co. v. Union Electric Co.*, 226 Fed. 482, the court holds:

“Merely changing the form or location of the mechanical elements of a patented structure does not avoid infringement, if such alterations are but different ways of mechanically expressing the dominant feature of the inventive idea and achieve the same result in substantially the same way.”

As said by Judge Nelson in *Tatham v. LeRoy* (2 Blatchf. 486):

“Formal changes are nothing—*mere mechanical changes* are nothing; all these may be made outside of the description to be found in the patent, and yet the machine, after it has been just changed in its construction, is still the machine of the patentee, because it contains his invention, the fruits of his mind, and embodies the discovery which he has brought into existence and put into practical operation.”

And the Circuit Court of Appeals for the Eighth Circuit in *Lourie Implement Company v. Lenhart* (130 Fed. 122) says:

“One may not escape infringement by adding or subtracting from a patented device by changing its form or by making it more or less efficient, while he retains its principle and mode of operation, and attains its result by the use of the same or equivalent means.”

As said by the court in *Eck v. Kutz* (152 Fed. 758):

“The question is whether the inventive idea expressed in the patent has been appropriated; and if it has, infringement has been made out.

“But with all this the operation is essentially unchanged, not only the whole, but of each part, and this is the significant thing.”

As said by the Circuit Court of Appeals for the Sixth Circuit, in *Vrooman v. Penhollow*, 179 Fed. 296:

“Whether an invention be a pioneer, or, being of small importance, is ranked at the foot of the line, the rule is that it shall be judged on its own merits; that is to say, according to the advance it has made in novelty and utility beyond the prior art.”

McSherry Mfg. Co. v. Dowagiac Co., 101 Fed. 716;

Penfield v. Chambers Bros. Co., 92 Fed. 639;

Paper Bag Co. case, 210 U. S. 405.

It is to be noted that the drawings of the defendant's machine inserted by defendant in the appellant's brief in appeal No. 2960, opposite page 76, do not illustrate in any manner these adjusting leaves or plates. It will be noted that the reason why defendant conceded that the injunction might issue under the *Robert Strain* re-issue against the use of the adjustments of

the brackets which held the rollers was because defendant contended it secured the adjustment of its grade openings by means of these adjustable leaves or plates X, and the lower court so found.

This alternative form of the Strain invention is covered by claims 5, 7, 8, 9, 10, 11, 12, 13 and 37, being in the latter claim claimed in combination with the second portion of the Strain invention, i. e., the distribution of the fruit in the given bin.

The correspondence of the defendant's machine to the respective combinations embraced within or called for by these respective claims may be pointed out as follows

STRAIN PATENT.

DEFENDANT'S MACHINE.

CLAIM 5.

(1) Traveling means for conveying fruit along a definite line of travel embracing movable opposite inclined portions, the belt 10 and the leaves 13.

The grading belt and the table or bed on which it is supported and having the plates inclined to correspond to the belt.

(2) Flexible means for retaining fruit on each side of said inclined portions.

The roller side of the grader which has its axis inclined with respect to the horizontal extension of the belt lengthwise of the grader.

In the Strain patent a "double" grader, i. e., one having two grade-ways, or

In defendant's machine the machine is "double" in the same sense and the

duplicate devices on each plates for adjusting the side, is shown. The leaves belt are arranged opposite 13 are arranged opposite those on the other side. each other so that both Thus corresponding to the sides are alike. intent of the claim.

Note the claim is not specifically limited to, nor does it care for or describe, any particular form or construction of means for moving the leaves up or down.

CLAIM 7.

(1) Traveling means The respective inclined for conveying fruit along grading belts. a definite line of travel (the opposite parts of the belt 10).

(2) Means embracing The plates on opposite movable opposite inclined sides of the machine for portions (leaves 13 on opposite adjusting and supporting sides of the machine the belt at the grade openings).

(3) A plurality of flexible inclined grading rods The two roller sections (a rod 20 for each grade-way) or sides of the respective run-ways.

(4) Means for rotating The means for rotating said rods in opposite directions (pulleys 25, shaft 26, Fig. III). the roller sections.

This claim is also for a double grader or a grader having two grading ways arranged opposite each other in one machine. So has defendant's machine. It is

double in the same sense. In both the respective opposite rods 20 or roller sections are rotated in opposite directions due to utilizing opposite sides for contact with the fruit.

CLAIM 8.

This claim differs from claim 7 only in that it calls for the direction of rotation of the grading rods or roller side of the runway to be rotated upward against the tendency of the fruit to pinch between the belt and the roller. This applies equally to defendant's machines.

CLAIM 9.

(1) Means for conveying fruit; the belt 10.	(1) The grading belts.
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(2) Means for <i>supporting</i> opposite sides of said belt in symmetrical positions; the leaves 13.	(2) The table and the movable plates.
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(3) Means for gaging fruit, the inclined grading rods 20.	(3) The two inclined series of rollers.
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CLAIM 10.

This differs from claim 9 only in the inclusion of means for rotating the grading rods or rollers. This means is necessarily found in defendant's machines.

CLAIM 11.

Also double grader claim differing from claim 10 by the addition of the limiting descriptive clause:

“the direction of movement of both rods” (element 3, claim 9) “being such that the moving under-surface of each rod is substantially away from the lower plane of the inclined parts of said belt” to prevent pinching the fruit. Same is true in identically same sense of the rotation of defendant’s roller sections.

CLAIM 12.

- | | |
|---|---|
| (1) A frame. | (1) The frame of the machine. |
| (2) A table consisting of a horizontal portion having a plurality of opposite hinged leaves (13). | (2) The table or support for the two grading belts, this table having the movable plates equivalent in function to the leaves 13. |
| (3) <i>Means</i> for supporting said leaves in a desired position (the adjusting devices 16). | (3) The adjusting and supporting screws and brackets for the plates. |
| (4) An endless belt (10). | (4) The grading belts (in two pieces instead of a single belt, but fully equivalent). |
| (5) <i>Means</i> for propelling the belt (pulleys 25, etc.). | (5) Suitable pulleys. |
| (6) <i>Means</i> for retaining fruit on said belt, etc. (the inclined rod 20). | (6) The inclined roller sections. |

Making an element in two pieces instead of one does not avoid infringement.

Standard Co. v. Fastener Co., 113 Fed. 162
(C. C. A.);

Kings County Co. v. U.S. Cons. Seeded R. Co.,
182 Fed. 59 (C. C. A., 9th Cir.);

Standard Caster Co. v. Caster Co., 113 Fed. 162
(C. C. A., 6th Cir.);

H. F. Braummer Co. v. Witte Co., 159 Fed.
726;

Bundy Co. v. Detroit Co., 94 Fed. 524, 538;

Mabie v. Haskell, Fed. Cas. No. 8, 653;

White v. Walbridge, 46 Fed. 526;

Weber v. Accessories Co., 190 Fed. 189;

Pederson v. Dundon, 220 Fed. 309;

Stockland v. Russell Co., 222 Fed. 906;

Yancey v. Enright, 230 Fed. 641 (C. C. A., 5th
Cir.)

CLAIM 13.

This claim differs from claim 12 solely in the inclusion as an element of

“means for adjusting each of said leaves independently of the others.”

No question can arise that defendant's machine has means for so independently adjusting each of the plates.

CLAIM 37.

(1) Means for conveying fruit (inclined belt ing belt.
10).

(2) An inclined grading-rod (rod 20).

(3) Means for rotating the rod.

(4) Means for supporting (the belt 10), consisting of the leaves 13.

(5) A bin arranged adjacent each leaf.

(6) Means for adjusting each leaf independently.

(7) A plurality of guards (36).

(2) The inclined roller-sections.

(3) Means for rotating the roller section.

(4) Means for supporting the grading belt including the table and adjusting plates.

(5) A bin arranged adjacent each adjusting plate or leaf.

(6) The rod and adjusting nut carried by the bracket for adjusting each plate independently.

(7) A plurality of barriers which may be and in use are actually arranged as specified.

Defendant relies upon the patent to Elithorpe No. 527,953, dated Oct. 23, 1894, either as an anticipation or as limiting the scope of this (for want of a better term) alternative invention of Thomas Strain. [See Transcript Record, pages 784 to 789.]

An alleged model of this device has been offered in evidence. In this connection it is to be borne in mind that the Elithorpe patent expired without a device of this kind ever having been used. The Ellithorpe patent was a purely "paper patent" the same as the Crosby patent before this court in Kings County Raisin & Fruit Co. v. U. S. Consolidated Seeded Raisin Co., 182

Fed. 59-62. The Ellithorpe device is shown by the testimony of complainant's witnesses to be impractical and the court can readily see from the model in evidence that it would be impractical. The friction of the belts would render the same impractical. This is set forth in the testimony of complainant [Transcript Record, page 450] as follows:

“Q. Now, based upon your experience, what have you to say as to whether a device constructed in accordance with the disclosure of this Ellithorpe patent, Defendants' Exhibit 1, would or would not be practical as an orange grader or sizing machine?

A. I don't think it would be practical.

Q. Why not?

A. Well, in the first place, the mechanical details of construction of that machine would kill it as a practical machine.

Q. What particular details, for example?

A. Well, take for instance that traveling conveyor there, which is whipped around a number of pulleys in this case, in this model, of course, there is only three grading sections, and therefore the labor and friction on the sectional traveling conveyor would be such that to make an extended machine as it would have to be in order to make it practical would be such that I know of no material or no fabric that that conveyor could be made of that would stand it. It would simply tear itself in two trying to drive it and keep it in motion. The reason for that is that the increased and added number of pulleys you would have to run it around, each and every one of those would increase the friction, not only the propelling friction but the breaking friction in the fabric

itself, so much so as to make it a practical machine, and in order to make it practical, it would have to be extended considerably beyond what this model is; I don't believe it could be done.

Q. Now, in regards, Mr. Stebler, to the adjustment of the traveling member toward and away from the roller, would you consider that practical or impractical?

A. I shouldn't consider that practical.

Q. What would be the effect if constructed as constructed in this model, of simply adjusting these wooden pieces toward or away from the belt?

A. Well, as long as you adjust them toward the belt, if you once got them up against the belt, I presume you could adjust that belt within reasonable limits, but when you come to adjust it backwards and away from the belt, it is a question of whether the belt would follow it or not.

Q. Would the adjusting towards the belts, and therefore, toward the roller, tend to increase the friction and labor, I believe you termed it, upon the pulleys?

A. It would increase the friction and labor on the conveyor.

Q. And that is one of the things you referred to as the reason why you thought, based upon your experience, such a device would be impractical?

A. Yes, sir."

The Ellithorpe patent construction is a thoroughly impractical one. The very fact that the Ellithorpe patent was issued twenty-three years ago, and not a single Ellithorpe machine has ever been used, so far as the

evidence in this case shows, is conclusive against its impracticability.

As said by this court in 182 Fed. 62, speaking through His Honor, Judge Gilbert:

“The Crosby invention undoubtedly anticipates and describes the whole theory of the Pettit patent; but it does not appear ever to have been put to use, and there is no evidence that any machine was ever constructed under it. *It is one thing to invent the theory of a machine. It is quite another thing to invent a successfully operating machine.*

“It would seem that it was one of those unsuccessful and abandoned inventions which are held to have no place in the art to which they relate. In an analogous case, Mr. Justice Brown said: ‘His efforts in that direction must be relegated to the class of unsuccessful and abandoned experiments, which, as we have repeatedly held, do not affect the validity of a subsequent patent.’ *Deering v. Winona Harvester Works*, 155 U. S. 286, 302, 15 Sup. Ct. 118, 124, L. Ed. 153.”

As said by the Supreme Court in *Coffin v. Ogden*, 18 Wall. 120:

“The invention or discovery relied upon as a defense, must have been complete, and capable of producing the result to be accomplished. If the things are embryotic or inchoate; if it rested in speculation or experiment * * * it cannot avail to defeat a patent founded upon a discovery or invention which was completed; while in the other case there was only progress, however, near that progress may have approximated to the

end in view. The law requires not conjecture but certainty."

It is well settled on authority that the fact that the Ellithorpe theory having never been used, the patent having long since expired, and being free to the use of all, not simply justifies, but on the contrary requires the court to place a narrow construction on its effect as an anticipation and as a limitation. The rule is that all doubt must be resolved against such a paper patent, in the very manner as applied by this court in the raisin seeder case, 182 Fed. 59.

As said in Hopkins on Patents, Sec. 211, page 263:

"Rule XXIX. THAT THE ALLEGED ANTICIPATORY MATTER HAS NEVER GONE INTO PRACTICAL USE MAY BE CONSIDERED IN DETERMINING THE QUESTION OF ANTICIPATION.

"Thus, Judge Putnam has said: 'Anticipatory matter which has never gone into practical use is to be narrowly construed.' Simonds Rolling Mach. Co. v. Hathorn Mfg. Co., 90 Fed. Rep. 201, 208, and Judge Buffington has said: 'In determining a question of this character it is a pertinent and reasonable inquiry, if it be true that the disclosure of an earlier patent was substantially that of Jones, why during a period of many years, was it not practically applied to the same use?' Carnegie Steel Co. v. Cambria Iron Co., 89 Fed. Rep. 721, 738; citing Regulator Co. v. Copeland, 2 Fisher 221, Fed. Cas. No. 2866. Judge Colt has said: "If the question of identity of method and result is doubtful, *the doubt must be resolved in favor of the successful patentee, who has in a practical way materially advanced the art.*" Simonds Rolling

Mach. Co. v. Hathorn Mfg. Co., 93 Fed. Rep. 958, 961; citing Washburn v. Gould, 3 Story 122, 144 Fed. Case No. 17,214."

Complainant's expert made the sketch Complainant's Exhibit 10 at Porterville from the defendant's machines. He testifies:

"In this sketch the part marked 'X' is a plate, which extends below the belt in an opening in the bed on which the belt runs. This plate is adjusted by a screw or bolt marked 'Y,' so as to raise or lower the belt, and adjust its distance from the roller marked 'Z'. This adjusting means is directly beneath the smaller portion marked 'Z' of the roller, so that this adjusted portion of the belt, together with the smaller portion of the roller, form the grade opening and this adjustment provides for adjusting the width of the grade opening. This is equivalent to the construction in Exhibit 3 (T. Strain patent) consisting of the inclined leaves referred to as hinged leaves 13, as shown in figure 8.

By the Court: Where is that?

A. (Indicating to the court): In figure 7 of Exhibit 3.

Q. I don't understand it. What is there in this drawing that is like this that raises the belt up?

A. The wedges shown in figure 9 at—

Q. Oh, this wedge thing?

A. The wedge, yes. It raises the hinged leaf.

Q. Oh, yes, I know what you are talking about now.

A. So as to adjust or vary the distance between the belt running on the hinged leaf and the rotating rod 20.

Q. (By Mr. Lyon): There are hinges at 14 of figure 17, so that you can raise the belt towards or drop it away from the roll or roller. Proceed, Mr. Knight.

A. The construction of this is different from that of the Porterville machine, in that the adjustable support for the belt is hinged, and its height is adjustable by a wedge, instead of being grooved (moved) directly up and down by a bolt as in the Porterville machine, but its effect upon the belt is just the same, and its effect on controlling the size of the grading opening is the same. In respect, therefore, to the mode of operation of the machine as a grader this part is the equivalent." [Transcript Record, pages 216-218.]

See also:

Mr. Knight's testimony on cross-examination,
page 234;

Defendant's witness Milligan, Record, page 309;

Defendant's witness Brookhart, Record, page
336;

Defendant's witness Ofstad, Record, page 384.

It is apparent from the testimony of these witnesses that there is no conflict of testimony as to this means of adjusting the grade-openings in defendant's machines.

As each of the elements of the machines performs its function in substantially the same manner as the corresponding element in the Strain patent disclosure, and performs substantially the same function, it is clear that there is true mechanical equivalency and infringement.

No simpler example of equivalency exists than the substitution of a screw for a wedge. This is one of Mr. Walker's examples in his treatise on "Patents."

In *Brown Bag Filling Machine v. Drohen*, 140 Fed. 97, 100, it is said:

"The similarities and differences of machines and combinations are to be determined by the offices or functions which they perform, by the principles on which they are constructed, and by the modes which are used in their operation. A device which is constructed on the same principle, which has the same mode of operation, and which accomplished the same result as another by the same or by equivalent mechanical means, is the same device, and a claim in a patent of one such device claims and secures the other." Citing *Machine Co. v. Murphy*, 97 U. S. 120, 125, 24 L. Ed. 935."

In *Bucher & Gibbs Co. v. International Harvester Co.*, 211 Fed. 475, it is said:

"The structure of the defendant is practically a copy of the structure made by complainant, with the exception that the anti-tilting devices are different in form and the manner of location, but perform substantially the same functions."

Referring again to this Kings County case in 182 Fed., at page 59, this court there says:

"It does not necessarily follow, from the fact that the claim describes a specific form of construction, that the inventor shall be limited to that form."

As said by the Supreme Court of the United States

“It is generally true, when a patentee describes a machine and then claims it as described, that he is understood to intend to claim and does by law actually cover, not only the precise forms he had described, but all other forms which embody his invention; it being a familiar rule that, to copy the principle or mode of operation described, is an infringement, although such copy should be totally unlike the original in form or proportions.”

“And, therefore, the patentee, having described his invention and shown its principles and claimed it in that form which most perfectly embodies it, is in contemplation of law deemed to claim every form in which his invention may be copied. * * *”

This court in the case of Los Angeles Art Organ Co. v. Aeolian Co., 143 Fed. 887, said:

“In passing upon the issue of infringement, the question to be determined is whether, under a variation of form or by the use of a thing which bears a different name, the defendant accomplished by his machine the same purpose or effect as that accomplished by the patentee, or whether there is a real change of structure or purpose. If the change introduced by the defendant constitutes a mechanical equivalent in reference to the means used by the patentee, and if besides being an equivalent it accomplishes something useful beyond the effect or purpose accomplished by the patentee, it will still be an infringement as respects what is covered by the patent, although the further advantage may be a patentable subject as an improvement on the former invention.” Citing the Blandy v. Griffith case, as follows:

“ ‘As long as the root of the original conception remains in its completeness, the outgrowth—whatever shape it may take—belongs to him with whom the conception originated.’ ”

The Circuit Court of Appeals of the Eighth Circuit, in *Lewis Blind Switch Co. v. Premium Mfg. Co.*, 163 Fed. 951, says:

“A patent for an invention which is neither primary nor a slight improvement on the prior art, but possesses substantial patentable novelty, covers a reasonable range of equivalents.

“In interpreting the claims of a patent, proper regard should be had to the natural import of the terms in question, the context and the specification.”

The Supreme Court has repeatedly held that a charge of infringement may be made out though the letter of the claims is avoided:

Machine Co. v. Murphy, 97 U. S. 120;

Ives v. Hamilton, 92 U. S. 426-431;

Morey v. Lockwood, 8 Wall. 230;

Elizabeth v. Pavement Co., 97 U. S. 126, 137;

Sessions v. Romadka, 145 U. S. 29;

Hoyt v. Horne, 145 U. S. 302.

This court has repeatedly held that without being a truly “pioneer” or “primary” invention the inventor may be entitled to a liberal application of the doctrine of equivalency.

Parker v. Stebler, 177 Fed. 210;

Stebler v. Riverside Hts. Assn., 205 Fed. 735.

In the Paper Bag Machine case the Supreme Court had before it a patent for an invention which had never been put to commercial use, the patent having been purchased and “shelved,” as the owner preferred to market another type of machine, just the same as complainant has preferred to market the Robert Strain grader, and has held the Thomas Strain grader from the market. Yet the Supreme Court of the United States did not hesitate to give the bag machine patent the recognition to which it was entitled and to broadly construe it. Its decision in that case is the modern rule on the doctrine of equivalency and utterly destroys the old claim that an invention must be “pioneer” or “basic” to be entitled to the doctrine of equivalency. See

Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405.

It is submitted that the decree of the District Court is in error and should be reversed and an injunction granted against the infringement of the Thomas Strain patent as herein urged.

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